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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/649,139	08/27/2003	Thomas D. Kleino	1001-039C1	5045
25215 7590 01/10/2008 DOBRUSIN & THENNISCH PC 29 W LAWRENCE ST SUITE 210 PONTIAC, MI 48342			EXAMINER TOLIN, MICHAEL A	
			ART UNIT 1791	PAPER NUMBER
			MAIL DATE 01/10/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/649,139	Applicant(s) KLEINO, THOMAS D.	
	Examiner Michael A. Tolin	Art Unit 1791	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 32 and 34-56 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 32 and 34-56 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 32-44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are rejected for the reasons set forth in paragraph 4 of the previous office action mailed 20 August 2007.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 32, 34-39, and 41-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chrysler (Document titled "Vibration Damping Material for 1995 Chrysler JA Program Door Beam" filed July 12, 2006) in view of the Admitted Prior Art

(specification, page 1), Ligon (US 5358397), and Hanley (US 5266133), and optionally further in view of Bryant (US 3872548).

The claims are rejected for the reasons set forth in paragraph 6 of the previous office action mailed 20 August 2007.

5. Claims 40 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chrysler in view of the Admitted Prior Art, Ligon and Hanley, and optionally further in view of Bryant as applied to claims 32, 34-49, and 41-43 above, and further in view of any one of Johansson (EP 0398586 A1), Kracke (US 5013597), or Ritzema (US 6024190).

The claims are rejected for the reasons set forth in paragraph 7 of the previous office action mailed 20 August 2007.

6. Claim 44 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chrysler in view of the Admitted Prior Art, Ligon and Hanley, and optionally further in view of Bryant as applied to claims 32, 34-49, and 41-43 above, and further in view of Kracke or Ritzema.

The claims are rejected for the reasons set forth in paragraph 8 of the previous office action mailed 20 August 2007.

7. Claim 40 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chrysler in view of the Admitted Prior Art, Ligon and Hanley, and optionally further in view of

Bryant as applied to claims 32, 34-49, and 41-43 above, and further in view of Fitzgerald (US 2002/0074827).

The claims are rejected for the reasons set forth in paragraph 9 of the previous office action mailed 20 August 2007.

8. Claims 45-48 and 50-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chrysler in view of Ligon and Hanley, and optionally further in view of Bryant.

The claims are rejected for the reasons set forth in paragraph 10 of the previous office action mailed 20 August 2007.

9. Claim 49 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chrysler in view of Ligon and Hanley, and optionally further in view of Bryant as applied to claims 45-48 and 50-56 above, and further in view of any one of Johansson, Kracke, or Ritzema.

The claims are rejected for the reasons set forth in paragraph 11 of the previous office action mailed 20 August 2007.

10. Claim 49 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chrysler in view of Ligon and Hanley, and optionally further in view of Bryant as applied to claims 45-48 and 50-56 above, and further in view of Fitzgerald.

The claims are rejected for the reasons set forth in paragraph 12 of the previous office action mailed 20 August 2007.

Response to Arguments

11. Applicant's arguments filed 6 November 2007 have been fully considered but they are not persuasive.

Applicant argues that the examiner has overemphasized advantages of precision and production rate taught by Ligon. This argument is not persuasive because no objective factual evidence has been provided to show that one of ordinary skill in the art would not have expected to achieve such benefits from Chrysler as modified by the Admitted Prior Art, Ligon and Hanley.

Applicant argues the examiner has not adequately responded to the evidence of unexpected results which constitutes two photographs on the last 2 pages and arguments by counsel on page 9 of the Response and Amendment filed 06 June 2007. These photographs and arguments are not supported by an affidavit or declaration. Arguments by counsel cannot take the place of evidence supported by an appropriate affidavit or declaration. MPEP 716.01(c). To the extent that the photographs are taken to be evidence, they are not persuasive because there is no indication that the composition of the expandable material of each specimen is the same, nor is there any specific explanation as to the manner in which each specimen was tested. Thus, it is not clear if the only significant variable which was changed was the manner of applying the expandable material. Further, the examiner took the position that Applicant's

recognition of an advantage not recognized by the prior art of record, that of eliminating sagging of the material during expansion, does not make the claims patentable since this advantage would flow naturally from following the suggestion of the prior art to use extrusion for improved precision and production rate (office action mailed 20 August 2007, pages 14-15). MPEP 2145(II). Because there is no objective factual evidence of record which shows one of ordinary skill in the art would not have expected to achieve the benefits of improved precision and production rate from Chrysler as modified by the Admitted Prior Art, Ligon and Hanley, the examiner's position is that the above noted photographs do not outweigh the motivation to apply the expandable material by extrusion in accordance with Ligon.

Applicant argues the claimed method is unobvious over the prior art of record because the method of Ligon is expensive, and requires significant effort in set up and design. However, the expense of using such a method does not make it unobvious. MPEP 2145(VII). The examiner has taken the position that balancing cost against art recognized parameters of precision, production rate, and human error involves no more than routine design choice well within the purview of one having ordinary skill in the art. Applicant has not provided factual objective evidence which shows that one of ordinary skill in the art would not have used the method of Ligon to perform the material application in Chrysler as modified by the Admitted Prior Art and Hanley. Further, it is known from the Admitted Prior Art to apply the expandable material by pumping rather than by application of a preformed material (Applicant's Specification, page 1).

Additionally, the claims do not exclude the use automated extrusion and thus the arguments are not commensurate in scope with the claims.

Applicant argues the examiner has not provided motivation to meet the claimed limitation of the expandable material filling a cavity between the reinforcement and exterior panel structure. However, Chrysler clearly teaches that the expanded material expands to contact and adhere to the exterior panel structure. Chrysler simply fails to explicitly recite that the exterior panel structure includes a door panel. However, the Admitted Prior Art applied against the claims states that "one popular technique utilizes a pumpable product consisting of a thermally activated polymeric material, which upon activation expands and fills the space defined between the intrusion device and the outer door panel." (Applicant's Specification, page 1). It also follows that applying sufficient material to accomplish this method step is inherently known. Thus the motivation to meet this claimed method step is to practice the method of Chrysler in accordance with known suitable methods as evidenced by the Admitted Prior Art in which the exterior panel structure includes a door panel to which the expanded material adheres.

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Michael A. Tolin whose telephone number is 571-272-8633. The examiner can normally be reached on M-F 9am to 5:30pm.**

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on 571-272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

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USPTO Customer Service Representative or access to the automated information
system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Michael A. Tolin



RICHARD CRISPINO
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TECHNOLOGY CENTER 1700